

Application No.: 10/028,978

Docket No.: 21994-00036-US

REMARKS

The Office Action and prior art relied upon have been carefully considered. In an effort to expedite the prosecution of the application, the specification has been reviewed and a number of informalities have been corrected.

A new title is being provided as required by the Examiner.

Claim 8 was objected to and the noted informality has been corrected.

Claims 1-9 were rejected under 35 U.S.C. §112 second paragraph for being indefinite. The Examiner is correct that the expression " $P < \lambda < NA$ " is unclear. The typographical error in the expression has been amended throughout the specification and claims to properly be -- $P < \lambda / NA$ -- so that the expression now correctly represents the description.

Prior to a discussion of the prior art a brief description of the claimed invention should prove useful to the Examiner.

An information recording medium is composed of a recording layer and a light transmission layer, these layers laminated on a substrate that is provided with a groove section and a land section formed alternately in parallel (e.g. see claim 1 and page 11, line 21 to page 12, line 1). The recording layer satisfies a relationship $P < \lambda / NA$ as explained on page 18 paragraph number [0025]. The thickness of the light transmission layer is within a range of 0.070 to 0.120 mm (see page 16, lines 21-28), and the land section is wobbled in the radial direction as result of the method of phase modulation (see paragraph numbers [0067], [0079] to [0087] on pages 38-39, 44-48).

Further, another feature of the present invention is such that scattering of the thickness of the light transmission layer is within a range of ± 0.002 mm all over the light transmission layer (see page 17, lines 5-6).

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These claimed features are lacking in the cited primary references to Ohgo (US 6,269,072) and Takeda (US 6,512,735). Although the remaining cited references indicate bits and pieces of dependent claimed features, the shortcomings of the primary references (Ohgo and Takeda) render unobvious the claimed subject matter as currently amended.

In *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984), the Court mandated:

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so. (Emphasis in the original).

In view of the above amendment, applicant believes the pending application is in condition for allowance.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 22-0185, under Order No. 21994-00036-US from which the undersigned is authorized to draw.

Dated: October 4, 2004

Respectfully submitted,

By 

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